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7/20/03

PATENT  
ATTORNEY DOCKET NO.: 044574-5045

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Roland E. BARON *et al.*

Application No.: 09/939,709

Filed: August 28, 2001

For: METHODS OF USING AGENTS THAT  
MODULATE BONE FORMATION AND  
INHIBIT ADIPOGENESIS

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Commissioner for Patents

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

This paper responds to the Office Action (Paper No. 15) dated May 15, 2003, time for response to which expired June 15, 2003. A petition for a one month extension of time is submitted concurrently, extending the period for response to July 15, 2003.

In response to the restriction requirement in the Office Action, Applicants respectfully elect, with traverse, Group IV, claims 23, 24, and 31-44, drawn to a method of identifying genes which are modulated by  $\Delta$ FosB. Additionally, Applicants elect *in vivo* methods practiced with transgenic animal. Claims 23 and 36-44 are readable upon the elected species.

**REMARKS**

Applicants respectfully traverse the Restriction Requirement. Specifically, Applicants respectfully traverse the species requirement. The Examiner has not properly set forth the requirements for the election of "patentably distinct" species between *in vivo* and *in vitro* methods. Applicants have discovered that overexpression of  $\Delta$ FosB in mice resulted in bone

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formation and that overexpression of ΔFosB inhibits adipocyte formation. The invention of Group IV is directed to a method of identifying genes that are modulated by ΔFosB. The claimed method of identifying genes that are modulated by ΔFosB can be practiced with *in vitro* or *in vivo* methods based on Applicants' discovery. Applicants understand that according to MPEP 809.02(a), Applicants will be entitled to consideration of claims to the other species upon allowance of the generic claim.

If there are any additional fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

**MORGAN, LEWIS & BOCKIUS LLP**

Dated: July 15 2003

By:   
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